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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,956	06/27/2001	William Michael Lafferty	DIVER1280-14	7268

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EXAMINER

FORMAN, BETTY J

ART UNIT

1634

PAPER NUMBER

DATE MAILED: 07/16/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,956

Applicant(s)

LAFFERTY, WILLIAM MICHAEL

Examiner

BJ Forman

Art Unit

1634

~ The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

RESTRICTIONS

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to an apparatus comprising a plurality of capillaries, classified in class 422, subclass 68.1.
 - II. Claims 11-20, drawn to a capillary and array of capillaries wherein the capillaries comprise a wave guide and filtering material, classified in class 435, subclass 288.2.
 - III. Claims 21-26, drawn to a method for incubating a bioactivity or biomolecule, classified in class 435, subclass 4.
 - IV. Claims 27-35, drawn to methods for incubating a sample, classified in class 435, subclass 4.
 - V. Claims 36-37, drawn to a method of recovering a sample, classified in class 436, subclass 161.
 - VI. Claims 38-43, drawn to a recovery apparatus, classified in class 422, subclass 81.
2. The inventions are distinct, each from the other because of the following reasons:
 - a. Inventions I, II and IV are independent and distinct apparatus. Inventions are independent and distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation and different functions. The apparatus of Invention I operates by spatially arranging capillaries of defined size and shape and the apparatus functions to provide an array of capillaries of defined dimensions. The apparatus of Invention II operates by providing capillaries with retaining means and

Art Unit: 1634

filtering means and the apparatus functions as a means for screening a sample. And the apparatus of Invention VI operates by integrating capillaries, a recovery tool and an ejector and the apparatus functions to coordinate ejection and recovery of a sample.

b. Inventions III, IV and V are independent and distinct methods. Inventions are independent and distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation and different functions. The method of Invention III operates by introducing in order, a first component, air and a second component and the method functions to incubate a bioactivity or biomolecule. The method of Invention IV operates by introducing a liquid comprising a detectable particle into capillaries, removing the liquid and introducing a second liquid and the method functions to incubate a sample of interest. And the method of Invention V operates by determining a coordinate position of a recovery tool, detecting a coordinate location of a capillary and providing contact between the capillary and recovery tool and the method functions to recover a sample from one of a plurality of capillaries.

c. Inventions III, IV & V and I, II & VI are related as processes and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process. The apparatus of Invention I can be used as a spotting apparatus to transfer liquids through the capillaries to a solid support. The apparatus of Invention II can be used as a filtering apparatus to filter impurities from a liquid sample. An the apparatus of Invention VI can be used as a filtering apparatus to aspirate a filtered sample. As such, each of the

Art Unit: 1634

apparatus can be used in processes which are each materially different from the methods of Inventions II, IV & V.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.
Patent Examiner
Art Unit: 1634
July 11, 2002